UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,465	04/24/2001	Seth Haberman	0813808.00123 US2	5373

545 7590 10/28/2008

IP Patent Docketing
K&L GATES LLP
599 Lexington Avenue
33rd Floor
New York, NY 10022-6030

EXAMINER	
VAN HANDEL, MICHAEL P	
ART UNIT	PAPER NUMBER
2424	

MAIL DATE	DELIVERY MODE
10/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/841,465	HABERMAN ET AL.	
	Examiner	Art Unit	
	MICHAEL VAN HANDEL	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date. _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 7/25/2008. Claims **1-19** are pending. Claims **1**, **16**, and **19** are amended. Claims **20**, **21** are canceled.

Response to Arguments

1. Applicant's arguments regarding claims **1**, **16**, and **19**, filed 7/25/2008, have been considered, but are moot in view of the new ground(s) of rejection.

Claim Objections

1. Claims **1-19** are objected to because of the following informalities:

Referring to claims **1**, **16**, and **19**, the examiner notes that the phrase "the personalized advertisement" lacks antecedent basis. Although each of the claims has a previous recitation of "personalized advertisements" and of a "personalized advertisement template," the examiner fails to find a previous recitation of a "personalized advertisement." As such, the examiner recommends that the phrase be changed to "a personalized advertisement" and interprets the claims in the Office Action below as though the recommended changes have been made.

Claims **2-15**, **17**, and **18** are objected to as being dependent on the above-mentioned independent claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims **1-5**, **8**, **9**, **12**, **13**, **15**, **16**, **18**, and **19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al.

Referring to claims **1**, **13**, **16**, and **19**, Ficco discloses a method/system for allowing the creation of a plurality of personalized advertisements to be viewed by an intended audience (see Abstract), comprising:

- creating a personalized advertisement template comprising a plurality of media slots in sequence (originally broadcast advertisement), wherein a plurality of different media segments are insertable into at least one of said slots and wherein each of the different media segments is a portion of a personalized advertisement (p. 1, paragraph 9; p. 2, paragraphs 23, 28, 35; p. 3, paragraph 47), each of the plurality of different media segments comprising one of: an audio segment (p. 4, paragraph 55), a video segment (p. 4, paragraphs 60, 61) , a graphics segment (p. 4, paragraphs 58-59), a rendering segment (p. 4, paragraphs 54, 57), and a segment of last minute information (p. 4, paragraph 60);
- transmitting a plurality of data streams to a receiving unit, each data stream delivering a different one of said plurality of media segments for said at least one of said slots (p. 2, 3, paragraphs 36-38), wherein said media segments are synchronized to begin

and end at substantially the same time (p. 3, paragraphs 45-47; p. 5, paragraphs 63-65, 75); and

- transmitting content selection information regarding content of said plurality of data streams to said receiving unit, said information including switch times for said plurality of synchronized media segments, wherein said receiving unit uses said content selection information to switch between said plurality of data streams to retrieve at least one of said media segments for each of said slots, to generate a customized broadcast transmission stream, thereby assembling a personalized advertisement (p. 2, paragraph 36; p. 3, paragraphs 45, 47; p. 5, paragraphs 63, 72, 75).

Ficco further discloses replacing an entire originally broadcast advertisement with a selected ad segment (p. 3, paragraph 46). Ficco does not specifically disclose that the plurality of data streams are transmitted simultaneously. Klosterman et al. discloses systems and methods for substituting alternative video and/or audio signals and/or graphics and/or text to be displayed on a viewer's television display monitor for the video and/or audio signals that would otherwise be displayed according to the channel to which the viewer has tuned the television set (see Abstract). Klosterman et al. further discloses providing alternative advertisements on separate simultaneously broadcast television channels, so that the receiver can tune between the different channels to receive content best suited for a particular viewer (p. 2, paragraphs 31, 32; p. 4, paragraphs 44-46). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the ad segment transmission of Ficco to be simultaneously

transmitted on alternate channels with the original broadcast, such as that taught in the video substitution system of Klosterman et al. in order to save storage space.

Referring to claim **2**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said receiving unit selects among said plurality of data streams in real time (on-the-fly)(Ficco p. 1, paragraph 7).

Referring to claim **3**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said personalized advertisement is viewed by a viewer as it is assembled (adapted on-the-fly as it is being broadcast)(Ficco p. 1, paragraphs 7, 9, 13; p. 2, paragraph 27; & p. 3, paragraphs 46, 47).

Referring to claim **4**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said receiving unit selects among said plurality of data streams based on said content selection information and information about a viewer who will view said personalized advertisement (Ficco p. 1, paragraphs 11, 12; p. 2, paragraph 26; p. 3, paragraphs 39, 40, 45-47; p. 4, paragraphs 58, 59; & p. 6, paragraphs 85-89).

Referring to claim **5**, the combination of Ficco and Klosterman et al. teaches the method of claim 4, further including providing a data stream with a default personalized advertisement to allow said receiving unit to display said default personalized advertisement without selecting between said plurality of data streams (Ficco p. 3, paragraph 46; p. 5, paragraphs 71-74; & Fig. 5).

Referring to claim **8**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said segments are incomplete parts of a personalized advertisement (Ficco p. 1, paragraph 9 & p. 3, paragraph 47).

Referring to claim **9**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said receiving unit is a set top box (Ficco p. 1, paragraph 8).

Referring to claims **12** and **18**, the combination of Ficco and Klosterman et al. teaches the method/system of claims 9 and 16, respectively, wherein said set top box momentarily switches from a first digital data stream to a second digital data stream to play out a personalized advertisement (Ficco p. 5, paragraph 75).

Referring to claim **15**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, further including a plurality of templates for creating said personalized advertisements, wherein said templates include video sequence templates and audio sequence templates (Ficco p. 4, paragraph 62).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim **6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al. and further in view of Ten Kate et al.

Referring to claim **6**, the combination of Ficco and Klosterman et al. teaches the method of claim 1. Klosterman et al. does not disclose that the plurality of data streams are MPEG encoded data streams. Ten Kate et al. discloses encoding video streams in MPEG-2 (col. 3, l. 39-41, 61-67). It would have been obvious to one of ordinary skill in the art at the time that the

invention was made to modify the transmission channels in the combination of Ficco and Klosterman et al. to be MPEG encoded, such as that taught by Ten Kate et al. in order to achieve a higher compression rate.

3. Claims **7**, **10**, **11**, **17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al. and further in view of Picco et al.

Referring to claim **7**, the combination of Ficco and Klosterman et al. teaches the method of claim 1. The combination of Ficco and Klosterman et al. does not specifically teach that the plurality of data streams are multiplexed into a transport stream. Picco et al. discloses multiplexing live television feeds 106, local content streams 108 and various other signals into a digital data stream that is then transmitted to a user (col. 8, l. 56-67 & Fig. 5). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the transmission channels in the combination of Ficco and Klosterman et al. to be multiplexed into a digital data stream, such as that taught by Picco et al. in order to provide individualized local content in a digital stream by transmitting to the user a single multiplexed data stream (Picco et al. col. 2, l. 42-44).

Referring to claims **10**, **11**, and **17**, the combination of Ficco and Klosterman et al. teaches the method/system of claims 9 and 16. The combination of Ficco and Klosterman et al. further teaches that the invention can receive analog television and digital television (Ficco p. 2, 3, paragraphs 37, 38). The combination of Ficco and Klosterman et al. still further discloses switching advertisements in response to a channel change command in the vertical blanking interval (VBI)(Ficco p. 2, 3, paragraphs 36, 37 & Klosterman et al. p. 3, paragraph 38). The

combination of Ficco and Klosterman et al. does not specifically teach that the set top box momentarily switches from an analog data stream to a digital data stream to play out a personalized advertisement triggered by VBI data. Picco et al. discloses a set top box 120 (Fig. 7) that can receive both analog data streams and digital data streams (col. 14, l. 62-67). Picco et al. further discloses that the set top box 120 activates a web browser in response to a user selection when the user sees a television advertisement, which references a particular web site (col. 14, l. 17-41 & Fig. 11). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the VBI triggered advertisement switching of Klosterman et al. to include switching from an analog stream to a digital stream to display advertising information, such as that taught by Picco et al. in order to provide a television viewer with advertising from the Internet.

4. Claim **14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al. and further in view of Kunkel et al.

Referring to claim **14**, the combination of Ficco and Klosterman et al. teaches the method of claim 1. The combination of Ficco and Klosterman et al. does not specifically teach including transition segments, which are inserted into a personalized advertisement between segments. Kunkel et al. discloses encoding video streams in MPEG1 or MPEG2. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the transmission channels in the combination of Ficco and Klosterman et al. to be MPEG encoded, such as that taught by Kunkel et al. in order to achieve a higher compression rate. Kunkel et al. further discloses sending I-frames continuously at the beginning of targeted ads, so that the set

top box tuners can quickly acquire the signal. Similarly, a continuous stream of I-frames is provided for the last few seconds of the advertisement to enable the tuners to quickly reacquire the original channel once the advertisement has concluded (p. 4, paragraph 31). It would have been obvious one of ordinary skill in the art at the time that the invention was made to modify the combination of Klosterman et al. and Kunkel et al. to include continuously sending I-frames at the beginning and end of advertisements, such as that taught by Kunkel et al. in order to facilitate seamless transitions between advertisements and original programming (Kunkel et al. p. 4, paragraph 31).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2424

MVH